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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,037	07/29/2003	Richard Henry Parker	5601	9275

7590

05/09/2005

John E. Vick, Jr.  
Legal Department, M-495  
PO Box 1926  
Spartanburg, SC 29304

EXAMINER
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ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/631,037

Applicant(s)

PARKER, R.

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 and 5-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for select embodiments of a polymer having a cohesion parameter of between 13 and 19 MPa<sup>1/2</sup>, it does not reasonably provide enablement for the breadth of polymers that may possess this characteristic. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to prepare the invention commensurate in scope with these claims.

Applicant has not at all addressed the Examiner's concerns concerning the scope of invention of the claims. As was pointed out earlier, *Applicant's own Specification* identifies a prior art system that comprises a crosslinkable silicone and an ethylene-methacrylate polymer but, according to Applicant, fails to anticipate the instant invention for the reason that the particular ethylene methacrylate polymers cited therein do not possess the cohesion parameter required of the second polymer. (Applicant is encouraged to review the correspondence dated October 16, 2004 for a more comprehensive explanation of the details.) This fact supports the notion of a substantial amount of unpredictability wherein it may not be properly assumed that, just because a given polymer is a species of a broader genus of polymers favored by Applicant, it will inherently possess the required cohesion parameter. As a result, a practitioner of

Art Unit: 1712

Applicant's invention would have to perform a measurement on any polymer not expressly disclosed by Applicant to have this attribute, to ascertain whether it falls within the scope of the invention, which represents an undue burden in the Examiner's estimation. Indeed, the genus of polymers aptly described as ethylene methyl acrylate contains perhaps hundreds of known and/or commercially available species. Testing every member of this genus alone would involve considerable effort. Of course, a similarly burdensome effort would be required to ascertain those members of, for example, isoprene elastomer or poly(vinyl chloride), that would fulfill the cohesion parameter limitation set out in the claims.

In the previous Office action, the Examiner had stated that, for the purpose of Examination, it would be presumed that, in those instances where no specific product was disclosed for a genus of polymer materials outlined in the table spanning pages 10-12 of the Specification, every species in that genus would inherently possess the cohesion parameter mandated by the claims. It was also stated that, where a specific product, or species, was mentioned in concert with a disclosed genus, only that species was believed to possess the required attributes. Applicant has responded by saying that the disclosure of representative product names is, by no means, considered to be exclusive of other compounds within that particular genus. However, Applicant has furnished no evidence that, in fact, there exist other species within those genus for which a "representative product" is mentioned that satisfy Applicant's requirements. Accordingly, the Examiner's interpretation remains the same absent any showing to the contrary.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al., U.S. patent Application Publication No. 2004/0063803 for the reasons made of record in the last Office action.

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Zolotnitsky, U.S. patent # 5,648,426 for the reasons made of record in the last Office action.

As a means of overcoming these rejections, Applicant has inserted the phrase, "wherein said coating is used to coat airbag fabric." This additional recitation is nothing more than a statement of intended use and, hence, is not assessed any patentable weight. The claim is still directed merely to a coating formulation and the applications for which it is intended are of no consequence to patentability.

Applicant has also tried to distinguish the differences in the claimed formulation and those of the prior art by pointing out that airbag coatings are in possession of properties different from those of compounded articles. However, no such properties are claimed.

***Allowable Subject Matter***

Claims 6-22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action. The Examiner was not able to ascertain an express motivation for adding any of the materials set forth in claims 6-9 to the products disclosed by the aforementioned references. Claims 10-20 are allowable over the prior art because, while there are numerous examples of airbag coatings having polysiloxane as a primary constituent, there was no mention of the utilization of silicone-based semi-IPNs as coating materials for airbags.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 3, 2005

*Marc Zimmer*

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*AU 1712*

*Margaret Moore*

MARGARET G. MOORE  
PRIMARY PATENT EXAMINER  
ART UNIT 1712